

REMARKS

I. Introduction

Claims 1, 3 – 14, and 17 – 21 are presently pending and finally rejected.

Following entry of the present amendment, claim 13 has been amended to correct a typographical error introduced in the Office Action Response dated July 27, 2009. It is believed no new matter has been added.

II. Rejections under 35 USC § 103(a)

Claims 1, 3 – 14, and 17 - 21 are rejected under 35 USC 103(a) as being unpatentable over Halliday (US 7,340,990) in view of Fox (US 2,977,231) and Rusoff (US 2,954,293).

The Examiner finds Halliday discloses a concentrate for producing an instant chocolate beverage which is in the form of a viscous liquid or gel having a viscosity of 1700-3900 mPa and a solids content of 64-70%. Fox is relied upon as an example disclosing chocolate beverage concentrates contain cocoa powder, i.e., solid content of about 64%, a cocoa content of about 8%, and a density of 1.31. Although Halliday does not disclose the presence of a cocoa taste enhancer, the Examiner finds Rusoff discloses a cocoa flavoring produced by macerating cocoa material in the presence of water to form a solution, and recovering and concentrating the juice to obtain a flavoring. Thus, it would have been obvious to modify the liquid chocolate concentrate of Halliday and Fox by including the chocolate extract as disclosed in Rusoff, and thus practice the claimed invention.

Applicants respectfully traverse this rejection, as a prima facie case of obviousness has not been established over the claims, and request that the rejection be withdrawn.

1. The scope and content of the Prior Art and Differences Between the Prior Art and Claimed Invention:

Independent claim 7 is directed to a composition comprising a cocoa taste enhancer (produced by a process comprising macerating cocoa nibs in the presence of water to form a juice, recovering the juice, and concentrating the juice), and cocoa powder.

Halliday discloses a liquid chocolate ingredient contained in a cartridge. Col. 6, line 62. Halliday provides no characterization of the ingredient, other than the ingredient has a viscosity

of between 1700 and 3900 mPa at ambient temperature, between 5000 and 10000 mPa at 0°C and a refractive solids of 67 Brix±3. Col. 12, lines 63 – 65.

Fox et al discloses various drink concentrates which are packaged in pressurized containers. One drink concentrate disclosed in Example 2 is a chocolate syrup containing cocoa.

Rusoff discloses a flavoring material extracted from cacao beans with solvents and water. Col. 3, lines 17 – 19. The extract may be separated from the cacao material, and concentrated. Col. 3, lines 24 – 25.

2. The obviousness determination

a. *Halliday is not prior art*

Applicants request the rejection be withdrawn as Halliday does not qualify as prior art over the present invention. The present application was filed under 35 USC § 371, claiming priority to PCT application No. PCT/FR04/01545, filed June 21, 2004, which claims priority to France Application No. 03 07 506 filed on **June 20, 2003**. Halliday has an earliest effective filing date of **January 23, 2004**, and thus does not qualify as prior art.¹ As Halliday is not prior art to the present application, Halliday cannot be used to form the basis of a 35 USC 103(a) rejection.

b. *The references fail to teach or suggest all of the limitations of the claims*

However, even if Halliday is being relied upon due to its priority claim to provisional application 60/462,538 filed April 11, 2003, the provisional application does not fully support the disclosure of the Halliday Patent.² The Halliday provisional application provides no disclosure of the liquid chocolate ingredient at column 12, lines 60-65 of the Halliday Patent. If Applicants are in error, Applicants request the Examiner to specifically identify where such a composition is disclosed in the Halliday Patent.

The remaining teachings of Rusoff and Fox fail to teach or suggest all of the limitations of the claims.

¹ It is clear Halliday's foreign application priority claim to GB 0301708.4 filed January 24, 2003 cannot be relied upon to establish priority over the present invention. See *In re Hilmer*, 149 USPQ 480 (CCPA 1966) and *In re Hilmer*, 165 USPQ 255 (CCPA 1970).

² Applicants do not concede use of a provisional application filing date to establish priority over claims is permissible.

c. *The references teach away from one another*

The Examiner finds as both the concentrate of Halliday and Fox and the extract of Rusoff are taught as flavorants for cocoa beverages, it is prima facie obvious to combine two compositions each of which is taught to be useful for the same purpose in order to form a third composition to be used for the very same purpose.

However, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Assoc. Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983).

Rusoff seeks to produce water-soluble flavor concentrate having chocolate flavor and aroma. Col. 1, lines 15 – 19.

Generally... the chocolate flavor is imparted to the beverage by using a low-fat cacao material, such as cocoa powder. At best, it provides a turbid product and, therefore, its use is mainly confined to milk. Even then it presents a problem in that some of the cocoa particles settle out and collect on the bottom of the bottle.... Many proposals have been advanced for dealing with the problem. For example, it has been suggested that gelatinized starches...be added to the beverage to hinder settling of the insoluble particles.... However, none of the above mentioned proposals have resulted in a satisfactory solution to the problem due to the foreign taste, increased viscosity, and in some cases the sliminess caused in the product by the additives.

Col. 1, lines 22 – 45.

It would be desirable, however, in meeting such end uses that the chocolate flavoring composition **not have present cacao solids** which as in the case of low fat cacao material require some type of suspending medium.

Col. 2, lines 49 – 53 (emphasis added).

Assuming the chocolate compositions disclosed by Fox and Halliday contain cacao powder, and Applicants do not concede this point, Rusoff clearly teaches away from adding cacao powder to its cacao flavoring composition.

Claims 1, 3 – 6, 8 – 14 and 17 – 21 all depend from claim 7. As the composition of claim 7 is neither disclosed or suggested by the teachings of Halliday, Rusoff and Fox, either

individually or combined, the references cannot teach or suggest all of the limitations of the claims that depend therefrom, and Applicants request the rejection be withdrawn.

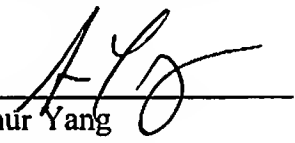
IV. Summary

Applicants have made a *bona fide* attempt to address all matters raised by the Examiner. Applicants respectfully submit that the application is now in condition for allowance, and therefore respectfully request that the outstanding rejections be withdrawn and that a Notice of Allowance be issued. If any remaining matters need to be resolved, Applicants respectfully request an interview with the Examiner prior to any official action being taken by the Office in response to these arguments and amendments in order to facilitate allowance of the pending claims.

It is believed no fee is currently required. If a fee is required, please charge the same to Deposit Account 50-4255.

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Respectfully submitted,

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